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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Peter Spencer EDWARDS

Serial No.: 10/643,013

Filed: August 18, 2003

Title: PRINTING ON MICROSCOPE SLIDES AND  
HISTOLOGY CASSETTES

Group Art Unit: 1762

Examiner: Kirsten Jolley

Attorney Docket No.: TOMK:009A

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Technology Center I, at telephone number: 703-872-9306

DATE: 03/30/05

By:   
MARC A. ROSSICOMMISSIONER FOR PATENTS  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450

## Facsimile Transmission

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From:	Marc A. Rossi
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COVER SHEET 1

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## INFORMATION DISCLOSURE STATEMENT

COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

Sir:

In order to comply with applicant's duty of disclosure, the undersigned attorney of record would like to bring the following information to the attention of the examiner:

1. On August 6, 2003, the undersigned attorney of record received a letter from Apogent's counsel (copy enclosed) alleging several instruments had been in use at the Mayo Clinic for more than twelve years, and further alleging the instruments constituted prior art with respect to U.S. Patent Application Publication No. 2001/0039896 A1.

2. U.S. Patent Publication No. 2001/0039896 A1 issued as U.S. Patent No. 6,615,763 on September 9, 2003 based on the parent application from which the present application claims priority.

3. Apogent's letter failed to include any supporting documentation for the allegations contained therein.

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4. Although applicant has no affirmative duty to seek out prior art, applicant authorized the undersigned attorney of record to investigate this matter by seeking additional information from Apogent.

5. The undersigned attorney of record requested that Apogent's counsel provide some evidence to support the allegations in the form of: technical publications describing the instruments in detail; operating manuals; work orders for the construction of the instruments; photographs or other materials that would clearly illustrate the actual instruments and their operation.

6. In response, Apogent's counsel forwarded a second letter of October 3, 2003 (copy enclosed) to applicant's attorney of record indicating he had contacted Mayo Clinic, but Mayo Clinic had no interest in cooperating in this matter and had no obligation to insure third party patents were valid. Apogent's counsel did offer the assistance of a Mr. William Hoffman, whom Apogent's counsel alleged was a former Mayo Clinic engineer responsible for the development of the instruments in question, and a picture alleged to be one of the instruments in use by Mayo Clinic. Finally, Apogent's counsel noted that he had no further obligation to put any more effort into gathering information.

7. Noting that applicant has no affirmative duty to seek out prior art, that applicant has no knowledge of the relationship between Apogent and Mr. William Hoffman, and that applicant has no way to verify any statements Mr. William Hoffman might provide given the refusal of Mayo Clinic and Apogent to provide further cooperation, applicant is providing all the information known to the applicant with respect to this matter to the examiner in order to fully comply with applicant's duty of disclosure, such that the examiner may determine whether this information is relevant and/or material to the examination of this application.

8. By the submission of this information, applicant does not concede that the alleged instruments constitute prior art. Applicant notes the original letter of Apogent only provides general comments and does not speak to the specifics of the structure or operation of the alleged instruments. For example, the letter provides no information as to whether the medium is directly sealed or as to the composition of the ink utilized. Further, it is not possible to ascertain whether the alleged use was in fact "public use" given the refusal of Mayo Clinic to

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cooperate. Finally, the picture provided by Apogent with the second letter fails to show any detail of the structure or operation of the alleged instruments.

It is requested that the examiner acknowledge receipt and consideration of this disclosure statement with the next correspondence from the Office.

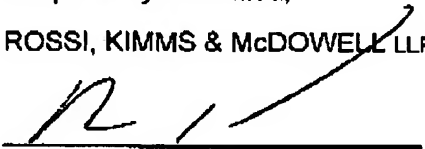
The Commissioner is authorized to charge any fees necessary to enter this paper to Deposit Account 18-2056.

Any questions regarding this issue may be directed to the undersigned attorney of record at the address and telephone number provided below.

Respectfully submitted,

ROSSI, KIMMS &amp; McDOWELL LLP

03/30/05  
DATE

  
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MARC A. ROSSI  
REG. NO. 31,926

P.O. Box 826  
ASHBURN, VA 20146-0826  
703-726-6020 (PHONE)  
703-726-6024 (FAX)